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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,969	09/04/2003	Jay S. Walker	3718582-00085	8907
29159	7590	12/16/2010	EXAMINER	
K&L Gates LLP			LIDDLE, JAY TRENT	
P.O. Box 1135				
CHICAGO, IL 60690				
			ART UNIT	PAPER NUMBER
			3716	
			NOTIFICATION DATE	DELIVERY MODE
			12/16/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,969	<b>Applicant(s)</b> WALKER ET AL.	
	<b>Examiner</b> Jay Liddle	<b>Art Unit</b> 3716	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42,43,47,48 and 51-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 42,43,47,48 and 51-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/15/2010 has been entered.

### ***Applicant's Submission of a Response***

2. Applicant's submission of a response was received on 11/15/2010. In the response Applicant amended claims 42, 43, and 51-61. Presently claims 42, 43, 47, 48, and 51-61 are pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 42, 43, 47, 48, and 51-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With regard to claims 42 and 43 the specification does not clearly disclose a triggering event followed by a

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determination afterwards. Rather, the disclosure clearly states, "If a "trigger" occurred (step 1220) then communication is initiated between the player and a casino rep (step 1230) and the casino rep may also provide a service to the player (step 1240)"

(Published application at [0107]). There is no language to be found anywhere in the application that has a triggering step and then an enablement step AFTER the triggering. With regard to claim 51, there is no discussion in the application of "instructions direct the processor to obtain a player identifier from the player." Rather, the specification states, "According to one embodiment, a player may identify himself. For example, a player may provide information about himself including the player's name, the player's identification number" (Published application at [0115]). While the specification discloses that a player *may* identify himself, there is no disclosure that requires the processor to obtain information about the player. Claims 47, 48 and 51 – 61 are rejected for depending from a previously rejected independent claim.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 43, 47, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 43, 47, and 48 recite the limitation "the individual" in part (b) of claim 43 and the last line of claims 47 and 48. There is insufficient antecedent basis for this limitation in the claim. Since claim 43 lacks the same limitation presented in claim 42 part (a) there is insufficient antecedent basis for

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part (b) in claim 43. Claims 47 and 48 are also rejected for being dependent on a rejected claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 42, 43, 47, 51, 52, 54, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,971,271 to Wynn.

With regard to **claim 42**, Wynn discloses a non-transitory computer readable medium encoded with instructions for directing a processor to: determine that a triggering event has occurred in association with at least one gaming activity at a gaming device, said at least one gaming activity including at least one random determination (col. 4, line 60 – col. 5, line 20); in respond to the determination that the triggering event has occurred, determine whether or not to enable a player associated with the gaming device to make an input to request at least one of a product or a service to be offered (col. 5, lines 10-13; col. 7, lines 28-59); if the determination is to enable the player to make the input to request the at least one of a product or a service to be offered and the player makes said input (col. 11, lines 1-25): (a) determine an individual to communicate with the player (col. 5, lines 30-39); (b) determine, based on the at least one gaming activity, the at least one of a product or a service to be offered to the player (col. 5, lines 1-20; col. 11, lines 1-15); (c) transmit, to the individual, data

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representing the determined at least one of a product or a service to be offered (col. 5, lines 1-20; col. 11, lines 1-25); and (d) enable communication between the player and the individual via a portable communication device (abstract; col. 2, line 20 - col. 3, line 29; col. 5, line 7 – col. 6, line 45; col. 7, line 28 - col. 9, line 33); if the determination is to enable the player to make the input to request the at least one of a product or a service to be offered and the player does not make said input, do not offer any product or any service to the player in association with the determination (inherent in that if the player never picks up the receiver to call or to answer a call then they will never receive any communication from the individual); and if the determination is to not enable the player to make the input to request the at least one of a product or a service to be offered: (a) do not enable the player to make said input; and (b) do not offer any product or any service to the player is association with the determination (col. 11, lines 40-49).

**Claim 43** add the limitation of monitor at least one gaming activity of a player at a gaming device, said gaming activity including at least one random determination which is disclosed by Wynn (Col. 4, line 60 - col. 5, line 20).

With regard to **claim 47**, Wynn discloses enable the individual to provide a service to the player (figs. 1-20A; abstract; col. 2, line 10-col. 3, line 29; col. 5, line 1 - col. 6, line 45; col. 7, line 28 - col. 9, line 33; col. 11, lines 1-64).

With regard to **claim 51**, Wynn discloses that the instruction direct the processor to obtain a player identifier from the player, the player identifier comprising a name of the player (col. 4, lines 49-52).

With regard to **claim 52**, Wynn discloses that the player identifier comprises an address of the player (col. 6, line 7).

With regard to **claim 54**, Wynn discloses that the player identifier comprises a tracking card of the player (col. 4, lines 49-52).

With regard to **claim 55**, Wynn discloses that the player identifier comprises a hotel room number of the player (col. 6, line 11).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,971,271 to Wynn in view of WO96/00950 to Walker.

With regard to **claim 47**, Wynn does not explicitly disclose that the processor can alter the state of the gaming device. However, Walker teaches a processor with instruction to alter the state of the gaming device based on an input received from the individual (page 31, lines 15-23). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the communication invention of Wynn with the altering ability of Walker in order for the personnel of Wynn to be able to fix minor errors remotely without having to send a person to the machine to fix a problem at the machine.

13. Claims 53 and 56-61 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,971,271 to Wynn in view of US Patent No. 6,012,983 to Walker.

With regard to **claims 53** and **56-61**, Wynn does not explicitly disclose the stored data as required by these claims. However, Walker teaches a database that stores information about players that includes a phone number, payment identifier, credit card number, financial account number, and address (fig. 4; col. 4, lines 51-63 and col. 5, lines 52-65). Furthermore, Walker teaches that any such database information could be kept that accurately relates to the individual which would include known items such as an email address or a debit card number (col. 4, lines 51-63; col. 5, lines 52-65). It



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would have been obvious to one of ordinary skill in the art at the time of the invention to combine the database of Walker with the communication invention of Wynn in order to better get track of players and offer them promotions through various other methods.

### ***Response to Arguments***

14. Applicant's arguments filed 11/15/2010 have been fully considered but they are not persuasive. Applicant argues on page 7 that "the only instance in Wynn which includes interaction between a player and the Concierge as a result of a triggering event occurring in association with at least one gaming activity which includes at least one random determination, appears to be an instance wherein a jackpot is won or wherein coin in/coin out data reaches a set level in a period off time." The Examiner disagrees and points out that Wynn clearly discloses that a concierge can be contacted when a machine is out of coins which would be a result of a random determination (i.e. if the machine has a high number of wins, or a big pay out, it will be more likely to be out of coins than a machine that has a lower number of payouts).

With regard to Applicant's argument on page 8 that states "The request for the dispensing of coins at a gaming device does not include any random determinations at all," the Examiner disagrees. The payout of coins is directly related to whether or not the game has won any coins or not which is a result of a random determination. Thus in payout of coins is directly related to a random determination.

With regard to Applicant's argument on page 9 that states, "Although a player (or a machine) may run out of coins/tokens as a result of gaming activity, the act of a player requesting coins/tokens...does not include any random determinations at all. The

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Examiner disagrees as discussed above. Furthermore, Wynn states that the machine being out of coins results in "The system 10 add[ing] machine identification (I.D.) to the player (I.D>) and information and machine diagnostics for forwarding from the central station to the repair service facility. If a concierge is available and a card club member is identified as playing that gaming device, the concierge may offer to be of assistance and apologize for any interruption." (col. 5, lines 6-13). Applicant has erred in that in this citation the player has not requested coins at all, until after the communication with the concierge has begun. Rather, as a determination of a random event of running out of coins, the player has the ability to contact the concierge if they have a playing club card inserted, thus directly reading on the claims as presented.

The Examiner has withdrawn rejections based on US Patent No. 6,139,431 to Walker.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay Liddle whose telephone number is (571)270-1226. The examiner can normally be reached on Monday - Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTL 12/10/10

/Dmitry Suhol/  
Supervisory Patent Examiner, Art  
Unit 3716